REMARKS/ARGUMENTS

Claims 1-9 and 14-44 are active in this application. Support for Claims 19-44 is found in Claims 1-18 and the specification as originally filed. No new matter is added by these amendments.

The rejections of Claims 1 and 5-18 under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a) in view of Strauch (U.S. patent no. 5,533,678) is respectfully traversed. Similarly, the rejections of Claims 1-9, 11, and 15 under under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a) in view of Ozaki (U.S. patent no. 5,896,904) is respectfully traversed.

The Examiner has alledged that Strauch and Ozaki "inherently" describe the rheology regulator as claimed. In particular, the Examiner contends that the specific surface area limitations that define the calcium carbonate and the oil absorption (in Claim 9) are inherent properties of the calcium carbonates described in each of these two patents. However, the Examiner has provided no proof of this. Rather, the Examiner is using Applicants' disclosure against them. As noted by the court in *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient to prove inherency. Inherency may not be established by probabilities or possibilities. Something that is inherent must inevitably be the result each and every time.

It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967).

As noted by the Board of Patent Appeals and Interferences in *Ex parte Skinner*, 2 USPQ2d 1788, before an Examiner can switch the burden of proof of showing non-inherency to the applicant, the Examiner must provide some evidence or scientific reasoning to establish

the reasonableness of the Examiner's belief that the functional limitation is an inherent characteristic of the prior art. In this case, the Examiner has provided no such evidence.

Strauch describes producing natural and/or synthetic calcium carbonates "which have an extremely high BET/N_2 specific surface area of over 20 m^2/g and more especially 20 to 50 m^2/g." (col. 2, lines 1-6). However, Strauch does not describe selecting natural calcium carbonate in preparing a rheology regulator as claimed, for example, in Claim 1. Thus, the Applicants request that the rejections based on Strauch be withdrawn.

Ozaki describes a tire tread made up of rubber, silica and carbon black as reinforcing agents. (col. 3, lines 14-19). Ozaki further describes that "where a silica having a large N2SA is added into the rubber component, calcium carbonate surface-treated with a fatty acid, resin acid, lignin, surface active agent or the like can be added to the rubber component prior to or simulatneoulsy with adding the silica." (Col. 3, lines 64-67). Ozaki does not describe selecting natural calcium carbonate, crushed to high degree of fineness, with a specific surface area of around 14 to 30 m^2/g in preparing a rheology regulator as claimed, for example, in Claim 1. In fact, the Examiner has not pointed to anything in Ozaki that suggests selecting particular sized particles when using calcium carbonate as an additive in the manufacture of tire treads. Thus, the Applicants request that the rejections based on Ozaki be withdrawn.

Further, new Claims 19-34 are not anticipated by or obvious in view of Strauch or Ozaki. Specifically, neither of these two cited publications describe a method of regulating the rheology during the manufacture of at least one of a sealant, an adhesive, a plastisol, and a rubber, comprising adding natural calcium carbonate as claimed in, for example, Claim 19. Moreover, neither publications describes or provides any suggestion for the advantages of

using the calcium carbonate as a rheology regulator in the claimed method. The surprising advantages are described in detail by the Applicants on page 1, line 20 to page 2, line 3 of the present specification.

The rejections under 35 U.S.C. § 112, second paragraph and 35 U.S.C. §101 are addressed by amendment. Therefore, withdrawal of these rejections is requested.

Applicants also request allowance of this application.

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